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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,407	11/14/2001	Moriaki Shimabukuro	PNDF-01180	7034

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EXAMINER	
LEZAK, ARRIENNE M	

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/987,407	SHIMABUKURO, MORIAKI	
	Examiner	Art Unit	
	Arrienne M. Lezak	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Examiner notes that Claims 1-7 have been amended, Claims 8-18 have been added and no claims have been canceled. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 25 February 2005 as reiterated herein below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over extensive consideration of US Patent 5,732,216 to Logan.

3. Regarding Claims 1-7, 8, 10, 12 & 14-18, Logan discloses a voice banner advertisement system, method and apparatus for performing an advertisement with voice comprising:

- a Web server constituted by Web page data transmission means for constituting contents data and banner advertisement data to be offered to a user to transmit the Web page data, (Fig. 1; Col. 4, lines 39-67; Cols. 5 & 6; & Col. 7, lines 1-2), and
- history information recording means for recording as history information the number of times at which a banner advertisement is

transmitted as history information, (Fig. 1; Col. 5, lines 35-38; Col. 6, lines 27-35; & Col. 8, lines 3-43), and;

- a user terminal constituted by communication means for performing data communication with the Web server through the network, (per new Claim 15), (Internet – per new claims 8, 12 & 18), (Fig. 1; Col. 3, lines 23-67; & Col. 4, lines 1-37),
- Web page browsing means for browsing a Web page offered by the Web server, (per new Claim 16), (Col. 5, lines 3-35), and
- voice synthesis means for extracting banner advertisement data from the received Web page data and converting the banner advertisement data into voice by voice synthesis to utter the banner advertisement data, (per new claim 14), (Col. 3, lines 32-41; Col. 4, lines 66-67; Col. 5, lines 1-31); and
- voice synthesis operation setting means for setting whether the voice synthesis means is made valid or not and transmitting the setting contents to the Web server, (per new claim 17), (Col. 7, lines 5-35; Col. 9, lines 18-27; Col. 10, lines 15-37; Col. 44, lines 16-60; Col. 44; & Col. 45, lines 1-16), and
- the Web server transmits the advertisement data to the user terminal only when the voice synthesis means is valid, (per new claim 10), (Col. 7, lines 5-35; Col. 9, lines 18-27; Col. 10, lines 15-37; Col. 44; Col. 44, lines 66-67; & Col. 45, lines 1-16).

4. Examiner notes that though Logan teaches advertisement data, Logan does not specifically teach banners. To incorporate banners into the Logan advertising data would have been obvious to one of ordinary skill in the art at the time of invention by Applicant as banners were well known in HTML and the use of the same for advertising and general information purposes would likewise have been a well known means by which to display information to a user.

5. Additionally, Examiner notes that Logan teaches user supplied information pertaining to a user dataset, which dataset obviously includes information pertaining to user apparatus "speech synthesis" capabilities, and which dataset aids in distinguishing between program segments used. Further, Logan teaches defining audio programming with HTML, wherein narrative content to be presented in audio form is described utilizing HTML, and wherein it would have been obvious to have default code as well as default pages available for distribution based on user response and capabilities, (as noted within the user dataset), for purposes of supplying properly formatted and readable pages based on user apparatus capabilities. Moreover, Examiner notes that an obvious and necessary functionality within a speech synthesis capable apparatus, (such as a cellular phone), would be a means by which to activate and de-activate the speech synthesis capability per the needs and circumstances of different users of the same apparatus. Thus, Claims 1-7, 8, 10, 12 & 14-18 are found to be unpatentable over considerable consideration of the teachings of Logan.

6. Regarding New Claims 9 & 13, Logan is relied upon for those teachings noted herein above. Logan further teaches a voice banner advertisement system wherein the

banner advertisement data in the Web page data comprises a voice synthesis tag, (Col. 5, lines 7-45), (Examiner notes that the use of hypertext anchors clearly reads upon the use of tags, wherein the use of said hypertext anchors would obviously encompass any and all program content, (including voice synthesis content), within an audio message exchange system such as Logan, which system clearly incorporates the use of voice synthesis). Thus, Claims 9 & 13 are found to be unpatentable over considerable consideration of the teachings of Logan.

7. Regarding New Claim 11, Logan is relied upon for those teachings noted herein above. Logan further teaches a voice banner advertisement system wherein the Web page data transmission means constitutes the Web page data including banner advertisement data on the basis of the setting contents, (Col. 7, lines 8-21). Examiner interprets "setting contents" to mean data transmitted based on a particular setting or set of preferences, wherein Logan clearly teaches the use of "user preferences" as the basis for data compilation and transmission. Thus, Claim 11 is found to be unpatentable over considerable consideration of the teachings of Logan.

8. Claims 1-18 are further rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,732,216 to Logan in view of US Patent US 6,587,127 B1 to Leeke. Logan is relied upon for those teachings noted herein above. Though Examiner finds that the use of banners within advertising space was well-known at the time of invention by Applicant, and as such would have been obvious to incorporate within the Logan system, per Applicant's request, Examiner further provides the Leeke art which clearly teaches the use of banner advertisements, (Figs. 37-39, 47 & Col. 32, lines 35-47). As

Leeke teaches a graphical user interface, (GUI), within an Internet environment, and incorporating banner advertising data, Logan clearly shows that the use of banner advertisements within web pages was well-known at the time of invention by Applicant. Moreover, as both Logan and Leeke teach Internet advertisements, it would have been obvious to incorporate a particular advertisement type, (i.e.: banners), as taught by Leeke, into the Logan system, rendering Applicant's invention unpatentable. Thus, Claims 1-18 are further found to be unpatentable over considerable consideration of the teachings of Logan.

Response to Arguments

9. Applicant's arguments filed 25 February 2005, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA

1971). Examiner has addressed Applicant's request for proof that banner advertisements were well-known at the time of invention, as noted herein above.

11. Regarding Applicant's argument that the banner advertisement data is not uttered, Examiner respectfully disagrees noting Logan's teaching of hypertext anchors, voice synthesis and advertising data, (Col. 4, lines 66-67 & Col. 5, lines 1-45), which advertising data would obviously include banner advertisements, (as noted herein above), wherein any information, (including, but not limited to the banner advertisements), within the Logan system could obviously be accompanied by the necessary hypertext anchors needed for voice synthesis of the same.

12. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the extraction, downloading and conversion of advertising data to maximize the display area of a portable terminal) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, Examiner notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576,

152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

13. Regarding Applicant's argument that a compilation file is not included in the web page data transmitted to the user, Examiner respectfully disagrees noting that the data transmitted to the user comprises a combination of all data transmitted from the server to the client, which data, (as clearly taught by Logan), includes, but is not limited to advertising data, (alone or within a compilation), and web page data. Additionally, as banner advertisements within web pages were well-known in the art at the time of invention, (Leeke), it would have been obvious for the advertisement data to come directly from the web pages, (and be extracted directly from the web pages), thus eliminating the need for separate advertisement data.

14. Examiner has addressed Applicant's Amendment, and has further rejected all claims, as noted herein above. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak
Examiner
Art Unit 2143d

AML

WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER